

## REMARKS

### **SECTION 103 REJECTION OF CLAIM 1**

*Walker*<sup>1</sup> teaches a system in which a customer identifies a product that he wishes to acquire. In exchange for a fee, a retail server executes a random process. Depending on the outcome of the random process, the customer will either receive the product by mail, or he will be provided with a discount toward purchasing that product.

#### ***Walker* fails to teach limiting dissemination of multi-media content**

As a threshold matter, *Walker* does not teach “a method for limiting dissemination of multi-media content,” as recited in claim 1’s preamble. *Walker*’s system is intended to work in a retail store, in which the goal is to sell goods, not to limit their dissemination.

The Examiner’s position is that *Walker*’s product could be a DVD, on which is encoded “multi-media content.”

As a threshold matter, *Walker* does not actually describe the sale of multi-media content. As a result, the combination of *Walker* and *Nakano* does not actually disclose each claim limitation. However, for reasons discussed below, even if *Walker* contemplated offering multi-media content, the claim limitations would not be met.

#### ***Walker* fails to teach transmitting content**

In *Walker*, there is no disclosure of transmitting content, whether goal-activated or otherwise, to the customer. As a result, *Walker* cannot disclose claim 1’s limitation of “transmitting the goal-activated content.”

According to *Walker*, a customer receives products through the mail. This is apparent from *Walker*, col. 4, lines 23-26, which states that “[i]f the outcome is a winning outcome, the product is shipped to the customer without charging the customer any additional fee for the product, except perhaps a shipping and handling fee.”

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<sup>1</sup> *Walker*, U.S. Patent No. 6,443,643.

Thus, if a customer were to win a DVD, that DVD would be *mailed* to the customer, not *transmitted*.

**Walker lacks teaching of a game challenge**

Since the customer's goal is presumably the acquisition of this hypothetical DVD, the Examiner appears to regard the content encoded on the DVD as "goal-activated content." The Examiner thus appears to define "goal-activated content" as being multi-media content that a customer wishes to acquire.

Applicant disagrees with the proposition that the broadest reasonable definition of "goal-activated content" includes any multi-media content that a customer desires. Under such a definition, there would be virtually no multi-media content in existence that is not in some way "goal-activated content."

Nevertheless, in an attempt to expedite prosecution, Applicant amends the claim to require that the player complete a "game challenge associated with the goal-activated content."

In *Walker*, the customer simply awaits the outcome of a random process. It is this random process that the Examiner presumably regards as a "game." However, there is no "game challenge" associated with *Walker*'s random process. *Walker*'s system offers no more of a "game challenge" than does a slot machine.

**Walker lacks teaching of receiving information from a player indicating completion of a game challenge**

As amended, claim 1 recites "receiving information indicating that a...player...has completed a game challenge."

In *Walker*, the random process is executed at the retail server. Therefore, the retail server would never be in a position to receive information from a player indicating that the player has completed a game challenge.

***Nakano*<sup>2</sup> fails to teach instructing client to delete content**

The Examiner concedes that *Walker* alone does not teach the limitation of instructing the client to delete goal-activated content stored on the client. The Examiner nevertheless proposes that this limitation is disclosed by *Nakano*.

*Nakano* teaches a video-recorder for deleting recorded television programs after the lapse of some pre-defined-interval. *Nakano* is relevant only because it shows that content can be deleted from a disk. But this is not what is claimed.

*Nakano* does not disclose instructing a client to delete goal-activated content. In fact, *Nakano* does not even describe any client/server relationship. Therefore, *Nakano*'s device cannot instruct a client to do anything for the simple reason that there is no client available to instruct.

**Combining *Walker* and *Nakano***

The Examiner states that "the only difference [between *Walker* and *Nakano*] is that dissemination or sale of a copy protected MPEG is described in the virtue of a WEB store and *Walker* describes the purchasing or winning of products from a WEB store."<sup>3</sup>

In fact, *Nakano* has nothing to do with web stores. *Nakano* discloses a video-recorder for recording television programs. *Nakano*'s device is more like a VCR than a web store.

Despite the fact that *Nakano* has nothing to do with web stores, the Examiner suggests that one of ordinary skill in the art would have found it obvious to modify *Walker*'s system so that *Walker*'s system would automatically instruct the customer's computer to delete the multi-media content that it earlier transmitted to that computer. The Examiner suggests that this would be obvious "to use all available web store teachings for the stores used in *Walker*'s invention."

According to *KSR v. Teleflex*,

[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.<sup>4</sup>

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<sup>2</sup> *Nakano*, U.S. Patent Pub. 2002/0120667.

<sup>3</sup> *Office Action*, page 3.

<sup>4</sup> *KSR v. Teleflex*, 550 U.S. \_\_\_, 127 S. Ct. 1727, 82 U.S.P.Q.2d 1385 (2007).

The Examiner's statement that one of ordinary skill in the art would have found it obvious to use all available web store teachings for *Walker's* store is a mere conclusory statement. It is conclusory because it states a conclusion without providing any cogent technical reasoning to arrive at that conclusion. Essentially, the Examiner's reasoning is that if two references are in the same technical field, any permutation or combination of features in those references is obvious as a matter of law. Accordingly, the proposed motivation to combine the references fails to meet the standard set forth by the Supreme Court in *KSR v. Teleflex*.

Moreover, one of ordinary skill in the art would have regarded the idea of reaching into the customer's computer to delete content that the customer has just paid for<sup>5</sup> as amounting to a form of theft. One of ordinary skill in the art would have had no basis for believing that *Walker's* retail store had any legal right to cause deletion of content lawfully acquired by the customer.

Accordingly, Applicant submits that the reasoning offered for modifying *Walker's* system to include deletion of content as disclosed by *Nakano* would have made no sense to one of ordinary skill in the art. The section 103 rejection is thus improper.

Claim 20 includes limitations similar to claim 1 and is patentable for at least the same reasons.

#### **SECTION 103 REJECTION OF CLAIMS 3, 8, AND 16**

The Examiner regards the purchase history referred to in column 11 of *Walker* as being the claimed "history profile."

However, claim 3 requires receiving the history profile *from the client*. In *Walker*, the history profile is maintained at the retail server, and is never received from the customer. Accordingly, *Walker* fails to disclose receiving the history profile *from the client*.

Claims 8 and 16 include limitations similar to claim 3 and are patentable for at least the same reasons.

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<sup>5</sup> Even if the customer had won the content, he would have paid the entry fee.

### **SECTION 103 REJECTION OF CLAIMS 4, 9, AND 17**

The history profile disclosed by *Walker* consists of a list of the customer's purchases. Its function is to determine whether the customer is entitled to preferential treatment on the basis of his past purchases.

*Nakano* discloses a video-recorder that automatically deletes television programs after the lapse of a predetermined time. The decision to delete television programs in *Nakano* has nothing to do with the customer's purchasing history, and is therefore not "in accordance with the history profile" as required by claim 4.

Claims 9 and 17 include limitations similar to claim 4 and are therefore patentable for at least the same reasons.

### **SECTION 103 REJECTION OF CLAIM 5**

The Examiner suggests that encryption is inherent in MPEG files for the purpose of limiting play.

Inherency requires that the allegedly inherent feature must exist given the disclosed features. Thus, the Examiner must establish that all MPEG files are necessarily encrypted. The Examiner has made no such showing.

In fact, there are many different ways for *Nakano*'s system to know how much time a television program can exist on the disk. For example, the *Nakano* system could be programmed to delete all television programs a fixed amount of time after they have been created. This method would not require any encryption of data. Alternatively, the MPEG file could be transmitted with cleartext data about its lifetime on a disk. This is not unreasonable since there is nothing particularly confidential about a file's lifetime, and therefore there would be no compelling need to encrypt it.

Applicant has provided examples of cases in which the function proposed by the examiner could be accomplished without recourse to encryption. Accordingly, Applicant has demonstrated that encryption is *not* an inherent feature of MPEG files as disclosed by *Nakano*.

Since the proposed combination of references fails to disclose encryption of goal-activated content, the section 103 rejection is improper.

### **SECTION 103 REJECTION OF CLAIM 6**

Claim 6 as amended requires transmitting, to the server, information indicating that a player has completed a challenge from the on-line game.

In *Walker*, the customer does not transmit any such information back to the retail server. It is, after all, the retail server that determines the outcome of the random process.

As discussed in connection with claim 1, *Walker* does not teach “receiving the goal-activated content from the server.” In *Walker*, a customer who acquires a product would receive it through the mail, not from the server.

With regard to the deletion of goal activated content, Applicant draws attention to the discussion of *Nakano* in connection with claim 1.

For the foregoing reasons, the section 103 rejection of claim 6 is improper and should be withdrawn.

### **SECTION 103 REJECTION OF CLAIMS 9 AND 17**

The Examiner states that receiving the deletion instruction “upon initialization of an executable program” is disclosed in paragraph 68 of *Nakano*. Paragraph 68 reads as follows:

The content reproduction control denotes the content reproduction limitation by the recording/reproducing block **13**. To be more specific, the content reproduction control instructs the recording/reproducing block **13** to delete the content of which viewable period has passed from the hard disk or disable the reading of the content of which viewable period has passed from the hard disk. Namely, any content of which viewable period has passed is disabled for its reproduction namely viewing for the purpose of protecting the content-associated rights such as copyright for example.<sup>6</sup>

The foregoing paragraph does not describe the initialization of any executable program, let alone the receiving of any deletion instructions upon such initialization. Paragraph 68 does

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<sup>6</sup> *Nakano*, para. 68.

not suggest in any way that block **13** is being initialized and that a deletion instruction is sent upon such initialization.

*Nakano* fails to teach the additional limitation of claim 7. Accordingly, even if one were to combine *Nakano* and *Walker*, the result would still fail to teach the claim limitation.

Claim 19 includes limitations similar to claim 7 and is patentable for at least the same reasons.

### **SECTION 103 REJECTION OF CLAIMS 10 AND 18**

The Examiner concedes that *Nakano* fails to teach claim 10's limitation of "receiving an instruction to delete all goal-activated content." However, the Examiner suggests that one of ordinary skill in the art would have found this obvious "to maximize improvement of *Walker/Nakano* invention by making it more versatile and easy to use."<sup>7</sup>

The Examiner's statement is a "mere conclusory statement" of the type forbidden by *KSR v. Teleflex*. It offers no reason for why one would have found it obvious to modify *Nakano* by allowing receipt of an instruction to delete all goal-activated content.

Contrary to the Examiner's position, one of ordinary skill in the art would have recognized that deleting all content would result in deleting video programming that has only been recently placed on disk. This would defeat the purpose of *Nakano*, which is to delete only expired video programming.

### **SECTION 103 REJECTION OF CLAIMS 12 AND 15**

Claim 12 recites "requesting goal-activated content in response to the completion of the game challenge."

Based on the Examiner's definition of goal-activated content, the request for goal-activated content would occur when the customer indicates a desire to acquire that content. This step is carried out *before Walker's* system ever executes the random process. Therefore, the request for a DVD in *Walker* cannot possibly be "in response to the *completion* of" the random

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<sup>7</sup> *Office Action*, page 4.

process for the simple reason that the random process of *Walker* would not yet have begun at the time the request is made.

Claim 15 includes limitations similar to claim 12 and is patentable for at least the same reasons.

### **SECTION 103 REJECTION OF CLAIM 13**

Claim 13 recites “transmitting the goal-activated content to the client *over a network*.”

As discussed in connection with claim 1, *Walker* ships products to the customer by conventional mail, and not “over a network” as required by claim 13. The only data transmitted to the client over the network is a web page announcing the unfavorable outcome of the random process.

With regard to the transmission of instructions to delete goal-activated content, Applicant draws attention to the discussion of *Nakano* in connection with claim 1.

### **SECTION 103 REJECTION OF CLAIM 20**

The Examiner asserts that *Nakano* teaches the processor recited in claim 20.

*Nakano* teaches a video recorder for recording video programming off the air or over the internet. This video programming is stored on disk and, after the lapse of some interval, automatically deleted.

Claim 20 recites “a processor configured for determining that the goal-activated content is to be transmitted to the client.”

The *Nakano* video-recorder does not transmit content to anybody. In *Nakano*, it is the television station (or internet broadcaster) that transmits content. The *Nakano* video-recorder only *receives* content. It does not transmit content.

Claim 20 also recites “a processor configured for... causing the transceiver to transmit the goal activated content to the client.”



As noted above, the *Nakano* video-recorder does not transmit content, whether goal-oriented or otherwise, to a client.

Claim 20 further recites “a processor configured for... causing the transceiver to transmit a deletion instruction for deleting the goal-activated content from the client.”

*Nakano* discloses deleting content, but it does so locally. *Nakano* does not transmit a deletion instruction to anybody. It simply executes a deletion instruction to delete content from its own local drive.

The Examiner concedes that *Nakano* fails to teach anything about “goal-activated content.” To remedy this deficiency, the Examiner draws attention to *Walker*.

As noted above, *Nakano* does not disclose a processor configured as claimed. *Nakano*'s lack of such teaching does not depend on whether the content is goal-activated or otherwise. Thus, to the extent *Walker* discloses goal-activated content (which, as discussed in connection with claim 1, it does not), such disclosure would be irrelevant. Even if the video programming described in *Nakano* were goal-activated content, *Nakano* would still fail to teach the limitations of claim 20.

The Examiner suggests that one of ordinary skill in the art would have found it obvious to modify *Nakano* to include goal-activated content “to make a web store more interesting for subscribers.”<sup>8</sup>

However, *Nakano* has nothing to do with web stores. *Nakano* is simply a video recorder for recording and automatically deleting video content. Such content comes off the air, via cable, or via a web site that broadcasts streaming data. No web store is involved in the operation of *Nakano*'s video-recorder.

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<sup>8</sup> *Office Action*, page 6.

The Examiner further states that “both references describe forms of obtaining products via a WEB store and any combination of the teachings would be obvious to one of ordinary skill in the art at the time of applicant’s invention and predictable.”<sup>9</sup>

As noted above, *Nakano* has nothing to do with web stores.

However, even if it did, the Examiner’s proposed reason to modify *Nakano* is a mere conclusory statement that, under *KSR v. Teleflex*, is inadequate to support a legal conclusion of obviousness. The statement merely states that two references are in the same general field of technology and concludes that as a result, any claim that includes some permutation or combination of features found in those references is per se obvious.

For reasons discussed above, *Nakano*, with its proposed modifications based on *Walker*, fails to render the subject matter of claim 20 obvious. Accordingly, Applicant requests reconsideration and withdrawal of the section 103 rejection.

#### **SECTION 103 REJECTION OF CLAIM 21**

Claim 21’s preamble recites controlling access “in a *multiplayer* game.”

*Walker*’s random process is analogous to a slot machine, or flipping a coin. It is a one-player game, not a multiplayer game.

Claim 21 also recites “maintaining a state for each player in a multiplayer game.”

*Walker*’s FIG. 8 simply shows how the game is played. There is nothing in FIG. 8 that suggests maintaining a state of each player in a multiplayer game. The only plausible state associated with a single player is whether the player has won or lost (step S860). But this state is not maintained. Instead, FIG. 8 shows that certain actions occur depending on the outcome of the game.

Claim 21 further recites “storing content in association with each of a plurality of states that can be reached by at least some of the players.”

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<sup>9</sup> *Office Action*, page 6.

The Examiner states that this limitation is met by *Walker's* description of a retail store in col. 3, lines 50-58. But this passage simply describes a building in which one displays merchandise, including possibly DVD's, for sale. There is no suggestion that, in this retail store, DVD's are somehow stored "in association with each of a plurality of states." For example, there is no suggestion that DVD's for players who have won the game are stored on the first floor, that DVD's stored for players who have declined to play are stored on the second floor, and that DVD's for players who have lost the game are stored upside-down in the basement. The idea that *Walker's* description of a retail store could possibly disclose "storing content in association with each of a plurality of states" is difficult to comprehend.

#### CONCLUSION

Now pending in this application are claims 1-23, of which claims 1, 6, 13, 20, and 21 are independent. No fees are believed to be due in connection with the filing of this submission. However, to the extent fees are due, or if a refund is forthcoming, please adjust our Deposit Account No. 06-1050, referencing Attorney Docket No. 19815-0015001.

Respectfully submitted,

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